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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,847

08/09/2006

Jack Taunton

018062-006210US

2596

20350

7590

09/28/2009

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EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

09/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,847	<b>Applicant(s)</b> TAUNTON ET AL.	
	<b>Examiner</b> Bruck Kifle	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5-8,10-47,50-54 and 58-65 is/are pending in the application.
- 4a) Of the above claim(s) 26-46,50 and 58-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5-8,10-25,47,51-54 and 60-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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Applicant's amendments and remarks filed 06/16/2009 have been received and reviewed. Claims 3, 5-8, 10-47, 50-54 and 58-65 are now pending in this application.

Claims 26-46, 50 and 58-60 are withdrawn from consideration as being drawn to non-elected subject matter.

Claims 3, 5-8, 10-25, 47, 51-54 and 60-65 are under consideration.

***Claim Rejections - 35 USC § 112***

Claims 3, 5-8, 10-25, 47, 51-54 and 60-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) In claim 3, the nature of "E" is still unclear. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants' arguments and amendments have been fully considered but not found persuasive. The variable "E" is defined as "comprises an oxo group bound to a carbon atom, an epoxide or an olefin conjugated to an electron withdrawing group." So, there are three options for "E."

First, is the group -C(O)- which has a dangling valency. It is unclear what is attached to the other end of the carbonyl group when one end is attached to the pyrrolopyrimidine.

The second possibility is "an epoxide" which is correctly named "epoxy" when it is a radical as currently intended. This is clear.

The last possibility is "an olefin conjugated to an electron withdrawing group." That is, Applicants intention is an alkene substituted by an electron withdrawing group. Since the electron withdrawing group has to be conjugated, common electron withdrawing groups such as halogens are excluded. Which electron withdrawing groups are intended?

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The term “comprises” is open ended because one skilled in the art cannot say what else is intended.

ii) The term “substituted” without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not. Applicants point to paragraphs 38, 42, 43 and 44 of the specification where mere examples have been listed. If these are the only intended substituents, these should be listed in the claims. If not and there are more intended this should be clarified so one skilled in the art can ascertain the metes and bounds of the claim.

iii) Regarding the term “heterocyclic,” Applicants have still not stated how many atoms make up the ring, which atoms (beyond the “typically oxygen, nitrogen, sulfur and or phosphorous”) are present, how many heteroatoms are present and how many ring(s) are intended. The definition at paragraph 42 is flawed.

iv) Regarding the definition of  $R^2$  as “carboxylic ester” and “carboxamide,” Applicants state that the groups -C(O)O- and -C(O)NH- are intended. Applicants have not said what the rest of the radical is. Is Applicants intention a carboxyl (-C(O)OH) or an alkoxycarbonyl (-C(O)-O-alkyl) and a carboxamido (-C(O)NH<sub>2</sub>) or is more intended?

Regarding the definition of  $R^5$  as “alkyl- or aryl-substituted ether, thioether, or amine,” Applicants state that these “refer to -O-alkyl, -S-alkyl, -NH-alkyl, or -O-aryl, -S-aryl and -NH-aryl, respectively.” These groups are commonly referred to as alkoxy, alkylthio, alkylamino or aryloxy, arylthio and arylamino, respectively.

A definition in the specification which distorts the meaning of an accepted term renders the claims confusing (In re Hill 73 USPQ 482).

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Claims 47, 51-54, 59 and 61-63 are again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The basis of this rejection is the same as given in the previous office actions and is incorporated herein fully by reference. The how to use portion of the statute has not been met.

The specification does not teach the skilled artisan how to use the instant compounds, what is accomplished, who the intended user of the method is and how one can say whether someone needs these methods.

Applicants' arguments have been fully considered but do not answer the question of how to use.

Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

As the Supreme Court said in *Brenner v. Manson*, 148 USPQ at 696: "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion." As U.S. Court of Customs and Patent Appeals stated *In re Diedrich* 138 USPQ at 130, quoting with approval from the decision of the board: "We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound in terms of possible use so general

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as to be meaningless and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates.”

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/  
Primary Examiner  
Art Unit 1624

BK  
September 23, 2009